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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,223	09/12/2003	Stephen D. Pacetti	50623.330	9127

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EXAMINER

EDWARDS, LAURA ESTELLE

ART UNIT	PAPER NUMBER
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1734

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05/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,223

Applicant(s)

PACETTI ET AL.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, and 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kachigian (US 5,084,005) for reasons set forth in the previous office action.

Claim Rejections - 35 USC § 103

Claims 2 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kachigian (US 5,084,005) for reasons set forth in the previous office action.

Claims 1, 2, 4-7, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jendersee et al (US 5,836,965) in view Helfrich (US 5,308,338) and Scanlon et al (US 2,845,346) for reasons set forth in the previous office action.

Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jendersee et al (US 5,836,965) in view Helfrich (US 5,308,338) for reasons set forth in the previous office action.

Claims 1, 2, 4-6, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frisch US (4,906,423) for reasons set forth in the previous office action.

Response to Arguments

Applicants' arguments filed 12/5/06 have been fully considered but they are not persuasive.

Applicants contend that Kachigian does not expressly disclose the size of the swab nor provide any information on the size of the swab nor that the swab can be used to support a stent during a coating application. Acknowledgement is made of the fact that Kachigian does not disclose the size of the swab or use of the swab to support a stent during coating. However, Applicants can readily appreciate that the structure as recited and required by claim 1 is provided by Kachigian. Claim 1 does not explicitly recite a size of the member such that Kachigian, as applied, does not have to show or teach a size of the swab. Apparatus claims are recited such that Kachigian only has to provide the structure claimed but does not have to teach the intended use of the apparatus for supporting a stent during coating. Applicants should be made aware of the fact that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Applicants contend that the swab of Kachigian is not capable of holding a stent. This argument is not deemed persuasive because the Kachigian swab has the pore based tip, which can be oval in shape as shown in Fig. 7 provided on a pointed handle as shown in Fig. 4 such that a user would be able to place the pore based tip on a stent end such that the swab would support or bear the weight of the stent.

Applicants contend that a stent has a shape and a size discernable from the prior art such that the member or element of Kachigian must provide an express or inherent disclosure indicating that it has an appropriate size to support a stent. This argument is well taken, however, Applicants' claimed invention as recited in claim 1 does not require that the member have a shape or a size. Therefore, Kachigian does not have to provide teaching to a shape or a size. As mentioned above, apparatus claims are recited such that Kachigian only has to provide the structure claimed but does not have to teach the intended use of the apparatus for supporting a stent during coating. The intended use of the apparatus has been given no patentable weight.

Applicants respectfully disagree with the 103 combination of Jendersee et al with Helfrich and Scanlon et al on the grounds that Jendersee et al in disclosing that the retainers or cuffs may be made from any implantable material, such as a polymer or type of metal does not make obvious the use of any shape or structural characteristic (i.e., porosity) in combination with the retaining members of Jendersee et al. This argument appears to provide that it would NOT have been obvious to one skilled in the art in reading the teachings of Jendersee et al to look at all known implantable material (regardless of shape or porosity of that implantable material). It is the Examiner's position that one of ordinary skill in the art would readily appreciate using any known implantable material to make the cuffs or retainers because Jendersee et al explicitly state that "conventional retainers may be made from any implantable material" (col. 7, lines 50-51). Helfrich provides information to cuffs or retainers made from porous type implantable materials including polymer wool, to sintered metal or other materials (see col. 4, lines 31-39). Because sintered metal is established as a known porous implantable material, it would have been obvious to one of ordinary skill in the art to use any known porous based sintered metal construction to

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provide for porous based sintered metal cuffs or retainers. Scanlon et al provide information from the sintered metal composite art, that would enable the routineer in the art to establish sintered metal bodies made of a closed pore construction (see col. 1, lines 15-23).

Applicants contend that there is no desire or motivation for modification of the support device of Jendersee et al because Jendersee et al teach the importance of a smooth outer surface to facilitate positioning of the support device at the implant site (col. 3, line 3) and a porous retaining member would be a rough surface hindering passage of the delivery device through vessels. This argument is not deemed persuasive because it appears to be a point made in Applicants' opinion. Jendersee et al teach that any implantable material can be used to make the cuffs or retainers such any implantable material would be capable of passage through the vessel regardless of the ease of passage of the delivery device. One of ordinary skill in the art would have been motivated to use any known and conventional implantable material, including porous and/or non-porous implantable material in so long as said material was able to retain the stent on the catheter whether the catheter was used in or out of the body.

Applicants contend that Scanlon et al do not provide for a closed pore construction at col. 1, lines 15-23. The citation does not explicitly state the sintered metal bodies being of closed pore construction but implicitly provides for a metal body being porous in some areas or of a different porosity or having no porosity with the latter encompassing a closed pore construction.

Applicants contend with respect to the 103 rejection of claims 27-32 that 1) neither Jendersee et al nor Helfrich mention anything about pretreating a stent, 2) there is no motivation to modify the device of Jendersee et al to have porous retainers and one would not be motivated to use porous retainers or cuffs to promote tissue growth. All arguments are well taken but a

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grant of patentability of claims 27-32 would be unwarranted because the intended use of the apparatus to pretreat the stent has been given no patentable weight; the motivation to use known implantable materials to make the retainers or cuffs is prompted by Jendersee et al as evidenced by col. 7, lines 49-52, and additional motivation is provided by Helfrich to use porous implantable materials in instances where the retainers or cuffs are intended to be used in body to promote tissue growth.

Applicants contend that the unsuitability in use of porous cuffs or retainers on the support device of Jendersee et al would negate the motivation to use porous implantable material to promote tissue growth as asserted by the Examiner. This argument rallies in line with the previous argument as to the intended use of the device. Jendersee et al explicitly provide for use of any implantable material to be used to make the cuffs or retainers (col. 7, lines 49-52) such that it would be common sense to the routineer in the art to use any appropriate or suitable implantable material to make the cuffs or retainers in the device of Jendersee et al.

Applicants contend that Frisch teaches against the foamed material member being made with an exclusively closed cell construction (col. 3, lines 61-65) such that there would have been no reason or motivation to arrive at a closed cell pore device. Applicants' use of the term "comprising" is deemed open ended language which would not exclude the teachings of Frisch to the use of a few open cells in combination with closed cells to arrive at the claimed invention. The claimed invention is deemed obvious in view of Frisch in that closed cell construction of the member is recognized.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Laura Edwards
Primary Examiner
Art Unit 1734

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May 1, 2007